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09 MAR 2000

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In re Application of  
GIORGIO (deceased) et al  
Application No.: 09/355,210  
PCT No.: PCT/EP98/00599  
Int. Filing Date: 04 February 1998  
Priority Date: 07 February 1997  
Attorney Docket No.: 515-4167  
For: MONOCYCLIC COMPOUNDS WITH  
FOUR BIFUNCTIONAL RESIDUES...

DECISION

This is a decision on applicants' "LETTER TRANSMITTING DECLARATIONS" filed in the Patent and Trademark Office (PTO) on 08 November 1999, which requests that the application be accepted under 37 CFR 1.42 as filed on behalf of a deceased joint inventor, Raffaello Giorgi.

**BACKGROUND**

On 04 February 1998, applicants filed international application No. PCT/EP98/00599 which claimed a priority date of 07 February 1997, and which designated the United States.

On 04 September 1998, a Demand was filed with the International Preliminary Examining Authority electing the United States. The election was made prior to the expiration of 19 months from the priority date, and as a result the deadline for submission of a copy of the international application (unless previously communicated by the International Bureau) and payment of the basic national fee was extended to expire 30 months from the priority date, i.e. 07 August 1999.

On 23 July 1999, applicants filed a transmittal letter for entry into the national stage in the United States which was accompanied by, inter alia, the basic national fee and a copy of the international application.

On 19 August 1999, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497 and a surcharge for providing the oath or declaration later than 30 months from the priority date were required.

On 08 November 1999, applicants filed the present response which was accompanied by, inter alia, a declaration of the inventors executed by the surviving inventors and two heirs of the deceased inventor.

### DISCUSSION

Pursuant to 37 CFR 1.42, first sentence:

"In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain a patent."

Section 409.01 of the Manual of Patent Examining Procedure (M.P.E.P.) states, in part:

"One who has reason to believe that he or she will be appointed legal representative of a deceased inventor may apply for a patent a legal representative in accordance with 37 CFR 1.42. Proof of the applicant's authority as legal representative may be filed after the filing date of the application...."

Application may be made by the heirs of the inventor, as such, if there is no will or the will did not appoint an executor and if accompanied by a certificate from the court that they are all the heirs and that the estate was under the sum required by state law for the appointment of an administrator.

A review of the declaration of the inventors reveals that cannot be accepted for the purposes of 37 CFR 1.42. Specifically, the declaration fails to positively list Mr. Giorgi as an inventor but rather lists (and is executed by) his heirs, Rosaria Pirari and Alberta Giorgi as inventors. Further, it is unclear in what capacity (i.e., as legal representatives or heirs) Ms. Pirari and Ms. Giorgi are executing the declaration in that it states that they are

"executing and signing the declaration to which this is attached as...legal representative (or heirs)" of Mr. Giorgi. Further, if they have not been legally named as the legal representatives of the estate, then the declaration must list and be executed by all of the heirs, and a review of the supporting documents which accompanied the declaration reveals that there are two additional heirs not named on the declaration. In the case of minor children, as appears to be the present situation, such a declaration should list them as heirs and be signed on their behalf by their legal guardian. Finally, the declaration is unacceptable in that it appears to have been altered after execution. Specifically, it appears that at some point after the signature blocks of the declaration were filled out by hand and signed, someone went back and struck out the various indications of citizenship and typed in "ITALY" as well as similarly inserting "ITALY" in the indicated residences. Such an alteration is improper (see MPEP 605.04(a)). Therefore, in that a proper declaration has not been submitted, applicants request for acceptance of the application under 37 CFR 1.42 may not be properly granted at this time.

### CONCLUSION

For the reasons discussed above, the request for status under 37 CFR 1.42 is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42". No additional petition fee is required.

Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Affairs Division of the PCT Legal Office.



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